



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,718	12/28/2001	Grigor Markarian	CITI0243	4085

7590 06/09/2004

George T. Marcou
Kilpatrick Stockton LLP
Suite 900
607 14th Street, NW
Washington, DC 20005

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/028,718	MARKARIAN ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	<i>ML</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Eerola (US 6,678,518).

Eerola teaches a method and system for dynamically converting data between a mobile station in a wireless communication network and an origin server in a wide area network, comprising:

Claims 1, 12 and 18, sending from a mobile station a WML encoded URL request for a resource (C. 4, L. 14; C. 5, L. 15-17); receiving said request at a gateway server and re-formatting said request into HTML format (C. 4, L. 15; C. 5, L. 18-26); communicating said re-formatted request to a particular resource information on the World Wide Web and receiving the requested resource information at said gateway (C. 5, L. 18-26); parsing said received resource information and re-formatting the processed information into WML encoded message to transmit it back to said mobile station (C. 5, L. 36-50). Information as to *merchant information* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that

Art Unit: 3629

differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Eerola would be performed the same regardless of the content of the resource information.

Claims 2-3 and 14-15, see claim 1.

Claims 4-5 and 16-17, see claim 1.

Claim 6. Said system, including a parsing engine, a communication module, a translation/formatting module, and an administrator module (C. 4, L. 13-34).

Claim 7, Said system, including a gateway server, thereby inherently indicating at least one database (C. 3, L. 10). Information as to *database is accessible by the state manager for coordinating functions* is non-functional language and not given patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 13, see claim 1. Information as to *purchase request* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembićzak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The method steps, disclosed in Eerola would be performed the same regardless of the content of the request.

Claim Rejections - 35 USC § 103

Art Unit: 3629

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eerola in view of Robertson (US 6,609,106).

Claim 8. Eerola teaches all the limitations of claim 8, except teaching notification system, and a payment authorization system.

Robertson teaches a system for providing electronic multi-merchant gift registry using a wireless phone, including a notification system and a payment authorization system [0028]; [0065]; [0071].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Eerola to include a notification system and a payment authorization system, as disclosed in Robertson, because it would allow users to conduct e-commerce via in any suitable location and at any time.

Claim 9. See claim 8. Information as to *communicating with the mobile device* is non-functional language and not given patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 11. Said database including user shipping address, a list of payment vehicles and a subscriber ID [0070].

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eerola and Robertson and further in view of Wells et al. (US 6,078,820).

Claim 10. Eerola and Robertson teach all the limitations of claim 10, except teaching a short message services system (SMS).

Wells et al. (hereinafter Wells) teaches a system for real-time SMS application messaging, which includes a SMS-linked server (C. 3, L. 8-9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Eerola and Robertson to include a SMS-linked server, because it would allow SMS system users to conduct e-commerce in any convenient location and any suitable time.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Application/Control Number: 10/028,718

Page 6

Art Unit: 3629

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600